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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,586	04/18/2005	Hansulrich Reisacher	270429US0PCT	1425
22850	7590	04/14/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
ABU ALL, SHUANGYI				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
04/14/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/531,586

Applicant(s)

REISACHER ET AL.

Examiner

SHUANGYI ABU ALI

Art Unit

1793

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 1/25/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/25/2008 has been entered.

Claims 7-9 and 11-15 are now pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-9 and 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It cannot be readily determined if all of the weight percentage recited in claims 1 are based on the total weight of the pigment preparation or, for example, the percentage of (B) and (C) are based on the total weight of the pigment (A).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-8 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. patent No. 4,234,466 to Takahashi et al.

The references differ from Applicant's recitations of claims by not disclosing identical ranges. However, the reference discloses "overlapping" ranges, and overlapping ranges have been held to establish prima facie obviousness (MPEP 2144.05).

Regarding claim 7, Takahashi et al. disclose a solid pigment comprising of 1-70% of pigment (col. 4, lines 9 and 10) and 27-96% at least one ethylenically unsaturated polymerisable compound (col. 3, lines 22 and 23) and 3-60% a resin (col. 3, lines 49 and 50).

Regarding claims 8 and 11, Takahashi et al. disclose a solid pigment comprising a titanium dioxide pigment having bead particle in the range of 0.1-0.5 mm (col. 8, lines 36 and 37). Although they are silent about the surface area as applicant set forth in claim 2, it is the position of the Examiner that the surface area of a particle is the function of the size and shape of the particle, the claimed surface area would be inherent to of Takahashi et al. See MPEP 2112.

Regarding claim 12, Takahashi et al. disclose an ethylenically unsaturated polymerisable compound, a resin and a pigment mixed by a conventional dispersing machine such as roller mill, a colloid mill, a fluid energy mill, an oscillation ball mill, and ball mill (col. 4, lines 16 – 22) and then dried to obtain solid pigment(Example 1).

Regarding claim 13 Takahashi et al. disclose that the solid pigment is incorporated by stirring (col. 8, line 33).

Regarding claim 14, Takahashi et al. disclose the solid pigment used in a coating composition (col. 8, line 46). Water is used in the process of making solid pigment (col. 3, lines 25 and 30).

Regarding claim 15, Takahashi et al. disclose the solid pigment can be used in coloring plastic and powdery paint (col. 8, lines 1-4). They also disclosed that the pigment and resin could be mixed through hot kneader, extruder and a hot miller (col. 1, lines 19-22)

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. patent No. 4,234,466 to Takahashi et al., in view of U. S. Patent No. 5, 112,404 to Sommer et al.

Regarding claim 9, Takahashi et al. disclose a pigment composition as applicant set forth in claim 1, but they are silent about the nonionic surface active additives based on polyether used in the composition.

However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use polyether based surface-active additive in the teaching of Takahashi et al., motivated by the fact that Sommer et al., also drawn to pigment preparation, disclose that It is advantageous to use surfactant such as alkoxylation product of alkylphenols, fatty amine and et al. in an amount of 0-20%, in particular in an amount of 0-10% based on the weight of the pigment in the pigment preparation (col. 9 line 66 to col. 10. line 25).

Applicant's arguments filed 12/21/07 have been fully considered but they are not persuasive. The examiner fully responded to these remarks in the advisory action, the content being incorporated herein by reference.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Marcheschi/
Primary Examiner, Art Unit 1793

sa